

In re Appln. of ALAM et al.  
Application No. 10/034,432

### REMARKS

Reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

#### Status of the Application

Claims 1-3, 5-30, 32-77 and 79-100 are currently pending. Claims 1-3, 5-7, 9-11, 17, 24, 29, 30, 34, 36-38, 48, 52, 57, 58, 60, 61, 66, 71, 72, 74, 75, 81, 87, 88, 90 and 91 are amended, while claims 4, 31 and 78 are canceled, without prejudice to reinstate. Claims 4-18, 31-45, 56-61, 64, 65, 70-75, 78, 79, 86-91, 94 and 95 are allowable pending resolution of the non-substantive rejections described below, and if they are amended to include all limitations of the base claim and any intervening claims. New claims 97-100 find support at e.g., page 6 of the application as filed.

#### Summary of the Office Action

The Office Action has entered a number of non-substantive and substantive rejections against the claims.

A. The non-substantive rejections (numbered to correspond to the numbered paragraphs in the Office Action) are as follows:

(1) Claims 1-11, 22-38 and 46-96: Non-enablement because an inventive diluent comprising a solubilizer and alcohol that is critical or essential to the practice of the invention is not enabled—the specification does not adequately disclose the use of an aqueous diluent absent a solubilizer and an alcohol that exhibits the ICG concentration properties without undue experimentation;

(2) Claims 1-11, 22-38 and 46-96: Non-enablement because the specification does not reasonably provide enablement for an enhanced ICG concentration that is stable for at least 24 hours comprised of just any aqueous diluent.

(3) Claims 1-96: Indefinite because the terms stable and stability cannot be ascertained because they are relative terms.

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B. The substantive rejections (also numbered to correspond to the numbered paragraphs in the Office Action) are as follows:

(4) Claims 1-3, 24, 29 and 30: Anticipated by U.S. Patent 5,394,199 to Flower ("Flower").

(5) Claims 52, 54, 62, 66, 68, 76, 80-82 and 92: Obvious over U.S. Patent 6,248,727 in view of Flower.

(6) Claims 53, 55, 63, 67, 77, 83-85, 93 and 96: Obvious over Zeimer in view of Flower and EP 0 589 825.

(7) Claims 19-21, 26-28, 48, 49 and 51: Obvious over Flower in view of Zeimer and U.S. Patent 5,762,957 to Melhorn ("Melhorn").

(8) Claim 50: Obvious over Flower in view of Zeimer, Melhorn and U.S. Published Patent Application 2002/0028474 A1 to Shibamura et al. ("Shibamura").

(9) Claims 22, 25 and 46: Obvious over Flower in view of Shibamura et al.

(10) Claims 23 and 47: Obvious over Flower in view of Shibamura and Zeimer.

#### Discussion of the Rejections

##### A. Non-Substantive Rejections

In view of the significant number of claims that are allowable from a substantive perspective, applicants have amended the independent claims in order to overcome the non-substantive rejections, and thereby expedite issuance of the application. As applicants respectfully disagree with the bases for these non-substantive rejections, they reserve the right to pursue claims without the limitations entered in this response in a continuation application.

Specifically, applicants have addressed the rejections of paragraphs 1 and 2 by amending the claims to include a solubilizer and alcohol as components of the claimed aqueous diluent. Withdrawal of the enablement rejections entered against claims 1-11, 22-38 and 46-96 is respectfully requested.

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The indefiniteness rejection set forth in paragraph 3 is addressed by introducing parameters by which the stability of the composition may be evaluated.

Support for these amendments may be found at, e.g., page 6 of the application as filed. No new matter is introduced into the application by way of these amendments.

B. Substantive Rejections

In order to expedite allowance of the application, applicants have introduced into each independent claim a composition limitation recited in these claims that have been deemed allowable. As each independent claim is now in condition for allowance, withdrawal of the substantive rejections is respectfully requested.

*Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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